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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,773	10/17/2000	Geoffrey B. Rhoads	60310	3646

23735 7590 05/04/2005

DIGIMARC CORPORATION  
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EXAMINER

HAILU, TADESSE

ART UNIT PAPER NUMBER

2173

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/690,773

Applicant(s)

RHOADS ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5,8,9,14 and 17-23 is/are allowed.
- 6) ☒ Claim(s) 1,2,6,10,11 and 15 is/are rejected.
- 7) ☐ Claim(s) 7,12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/19/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



**DETAILED ACTION**

1. This Office Action is in response to Remarks submitted on January 19, 2005 for the patent application number (09/690,773) filed on 10/17/2000.
2. The instant application claims priority from US Application number 08/508,083, filed July 27, 1995 (now US Pat No 5,841,978).
3. The Information Disclosure Statement submitted on January 19, 2005 is considered and entered into the file. One of the references in page 3, on the IDS does not include a publishing date, thus not considered.
4. The pending claims 1-15, 17-23 are examined herein as follows.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 6, 10, 11, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Benade et al (US Pat No 5,621,864).

With regard to claim 1:

Benade discloses a system (label generation systems) for enabling a user to associate a machine behavior (e.g., printing and labeling) with a physical object (e.g. label, Figs. 4 through 8).

Benade discloses a registration system (column 6, lines 49-65) enabling a user to specify a machine behavior (e.g. printing) to be associated with a physical object (e.g. printing on the physical object or label) via an object identifier (e.g. indicia, wherein each label in a series of labels includes unique indicia that individually identify each label according to any predefined sequence, See Abstract). Furthermore, The indicia (e.g. bar code) can be read by a machine for pricing or object identification purposes (column 9, lines 21-29).

Benade also discloses a database management system (column 7, lines 29-43, column 13, lines 41-63, column 16, lines 6-20, Fig. 13) in communication with the registration system for receiving and maintain records associating object identifiers with machine behaviors (e.g. printing) wherein the database management system is operable to receive object identifier (see Fig. 13) and in response, to initiate the machine behaviors associated with the object (column 9, lines 10-21, column 11, lines 19-31).

With regard to claim 6:

Benade also discloses a user interface (Fig. 1, 114) that enables a user to view an image of an object along with an image of a behavior to be associated with the object (e.g., labeling or printing), the user interface (114) including a control (Fig. 15)

that enables the user to associate the object (e.g. rectangular label) with the behavior (printing on the label), and the user interface being operable to communicate a database structure (Fig.13) to the database management system specifying an object for the object and a description of the behavior (printing on the label).

With regard to claim 10:

Independent claim 10 corresponds generally to independent claim 1 and recites similar features in method form, Benade further describes receiving an object identifier, UPS Code read (or decoded) from machine readable code, that is bar code on the sheet of label (or physical object) (column 6, lines 35-65).

With regard to claim 11:

Benade discloses the specification of the object (e.g., label) includes a registration id provided on the object (see Figs. 4 through 8).

With regard to claim 15:

Independent claim 15 corresponds generally to independent claim 1 and recites similar features in storage form, and therefore is rejected under the same rationale.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benade et al (US Pat No 5,621,864) in view of Houser et al (US Pat No 5,606,609).

With regard to claim 2:

Claim 2 requires a network interface to associate behaviors with the object identifiers from remote client computers. The system of Benade does not show a network interface. Houser discloses a computer networks that are used for an electronic document verification system (column 1, lines 24-32, column 8, lines 50-65).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the network interface of Houser to the system of Benade because the Benade will be able to link to outside network to exchange data (Houser, column 1, lines 24-32).

Therefore, it would have been obvious to combine Houser and Benade to obtain the invention as specified in claim 2.

### ***Response to Arguments***

7. Applicant's arguments filed January 19, 2005 have been fully considered but they are not persuasive. The Applicant states that the Office appears to contend that "printing" corresponds to a "machine behavior to be associated with a physical object via an object identifier". To begin use, "printing" was recited as example, not a limiting factor that is associated with machine behavior; one other machine behavior is "reading" UPC code.

Applicant argues that Benade's system does not initiate such behavior in response to receiving an object identifier as claimed. In contrast to the Applicant argument, Benade describes initiating such as reading the bar code by the bar code

reader (or machine) for transmitting to, for example, the printer (column 13, lines 41-63, column 20, lines 13-16).

In particular the applicant argues that Benade does not teach a database management system that is operable to receive an object identifier and in response, initiate printing that has been associated with that particular object identifier. In contrast to the applicant's argument Benade describes a database management system (column 7, lines 29-43, column 13, lines 41-63, column 16, lines 6-20, Fig. 13) that is operable to receive an object identifier bar code (or UPC code) and in response, initiate, e.g., reading that has been associated with that particular object bar code identifier.

The Applicant argues that Benade fails to disclose initiating a behavior in response to an object identifier decoded from a machine-readable code as claimed. In contrast to the Applicant's argument Benade describes initiating a behavior, for example "reading" in response to an object identifier (i.e., UPC code) decoded (i.e., read) from a machine (i.e., bar code reader) readable code (column 9, lines 22-53) as claimed.

Applicant also argues that Houser does not teach network interface that enables users to associate behavior with object identifiers from remote client computers. In contrast to the Applicant's argument Benade in view of Houser teaches network interface (e.g., LAN and WAN interfaces) that enables users to associate behavior with object identifiers from remote client computers (column 8, lines 50-65).

***Allowable Subject Matter***

8. Claims 3-5, 8-9, 14, and 17-23 are allowed.

The following is an examiner's statement of reasons for allowance:

While Houser describes embedding a security object using, for example an object linking and embedding (OLE) technology, but Houser's security object is not embedded by "altering signals that are to form part of the objects to embed the object identifiers in the signals in a machine readable form" as recited in claims 3 and 4.

While the Benade in view of Houser describes watermarked electronic object, but Benade in view of Houser fails to describe that the object as being a watermarked sticker as recited in claim 17, the object as being a prop (claims 18 and 20), and the watermarked electronic object having two or more facets (claim 19).

The prior art of records further fails to describe the machine behavior (task) to include launching an e-mail program that is directed to a destination associated with the object via the watermark (claim 21), fetching a web page (claims 8 and 9), the machine behavior (task) to include launching an Internet chat session (claim 22), and the machine behavior (task) to include placing a telephone call to a destination associated with the object (claim 23).

The prior art of records further fails to describe at least the user interface is a web page based interface, and the user establishes a connection with the web based interface automatically in response to decoding the watermark on the object as recited in claim 14.

9. Claims 7, 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 7, the claim calls for the object identifier (i.e., physical object) embedded into the object using a watermark, in contrast, Houser's security object is inserted in an electronic file (which is NOT a physical object) using object linking and embedding (OLE) technology.

Regarding claim 12, the claim calls for the registration identifier is embedded in a watermark on the object (physical object). But, Houser's security object is embedded into electronic file, not embedded in a physical object.

Regarding claim 13, again Benade in view of Houser fails to describe decoding a watermark from a physical object as claimed.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 8:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu  
Patent Examiner  
April 19, 2005

A handwritten signature in black ink, appearing to read 'Tadesse Hailu', is written over the typed name and date.